

Serial No. 10/658,616

Docket No. 15916-271Fx

## REMARKS

### I. PRELIMINARY REMARKS

Claims 12, 16, 18 and 19 have been amended. No claims have been canceled. Claims 21-24 have been added. Claims 12, 14-16 and 18-24 remain in the application. Reexamination and reconsideration of the application, as amended, are respectfully requested.

### II. PRIOR ART REJECTION

#### A. The Rejection

Claims 12, 14-16, 18 and 19 have been rejected under 35 U.S.C. § 102 as being anticipated by the U.S. Patent No. 5,730,124 to Yamauchi ("the Yamauchi '124 patent").<sup>1</sup> The rejection under 35 U.S.C. § 102 is respectfully traversed with respect to the claims as amended above. Reconsideration thereof is respectfully requested.

#### B. Discussion Concerning Claims 12, 14 and 15

Independent claim 12 calls for a combination of elements including, *inter alia*, "a shaft" and "an electrode, carried by the distal region of the shaft, defining a distal region and **a pair of exterior openings** in the distal region of the electrode, and located **distally of the distal end of the shaft**, connected by a through hole extending through

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<sup>1</sup> Applicant notes that although claim 20 was mentioned in the statement of rejection at the bottom of page 2 of the Office Action, the body of the rejection did not include any mention of claim 20 or the combination of elements recited therein. Accordingly, applicant has assumed for the purposes of this response that the reference to claim 20 was a typographical error and that claim 20 is in condition for allowance. Should this assumption be incorrect, applicant hereby requests that the status of claim 20 be clarified in the next Office Action.

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the electrode, the through hole being closed but for the exterior openings in the distal region of the electrode." The combinations defined by claims 14 and 15 include, *inter alia*, the elements recited in claim 12.

The Yamauchi '124 patent fails to teach or suggest the claimed combinations. For example, the Office Action has apparently taken the position that the Yamauchi electrode plate 60 corresponds to the claimed "shaft," and that the electrode 72 and the ends of the electrode through hole 70 respectively correspond to the claimed "electrode" and "pair of exterior openings." [Note Figures 3 and 4.] Even assuming *arguendo* that this is a reasonable interpretation of claim 12, the openings in the Yamauchi electrode through hole 70 are not located distally of the distal end of the electrode plate 60.

As the Yamauchi '124 patent fails to teach or suggest each and every element in the combination defined by independent claim 12, applicant respectfully submits that the rejection of claims 12, 14 and 15 under 35 U.S.C. § 102 should be withdrawn.

### C. Discussion Concerning Claims 16, 18 and 19

Independent claim 16 calls for an electrode comprising "a main body portion," "a pair of exterior openings ... connected by a through hole" and "***means ... for mounting the main body portion on the distal end of a hollow cylindrical shaft.***" The combinations defined by claims 18 and 19 include, *inter alia*, the elements recited in claim 16.

The Yamauchi '124 patent fails to teach or suggest the claimed combinations. For example, with respect to claim 16, the Office Action has taken the position that the Yamauchi electrode plate 60 is the "main body portion" of the electrode 74. The inaccuracy of this position notwithstanding, the Yamauchi '124 patent does not even remotely suggest that any of the structure disclosed therein performs the function of mounting the electrode plate 60 on the distal end of a hollow cylindrical shaft.<sup>2</sup>

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<sup>2</sup> "[T]he application of a prior art reference to a means or step plus function limitation ***requires*** that the prior art element ***perform the identical function*** specified in the claim." [MPEP 2182, emphasis added.]

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As the Yamauchi '124 patent fails to teach or suggest each and every element in the combination defined by independent claim 16, applicant respectfully submits that the rejection of claims 16, 18 and 19 under 35 U.S.C. § 102 should be withdrawn.

### **III. NEWLY PRESENTED CLAIMS 21-24**

Newly presented independent claim 21 is directed to "an electrode for use with a surgical device." The electrode comprises "a main body portion defining a distal region, a proximal region, a longitudinal axis and an interior lumen extending along at least a portion the longitudinal axis" and "a pair of exterior openings formed in the distal region of main body portion without any structural member therein and connected by a through hole extending through the main body portion, the through hole being closed but for the exterior openings in the distal region and at least a portion of the through hole being oriented at a non-parallel angle to the longitudinal axis of the main body portion." Applicant respectfully submits that the Yamauchi '124 patent fails to teach or suggest such a combination and, accordingly, that claims 21-24 are patentable thereover.

### **IV. CLOSING REMARKS**

In view of the foregoing, it is respectfully submitted that the claims in the application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are respectfully requested. Allowance of the claims at an early date is courteously solicited.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call applicant's undersigned representative at (310) 563-1458 to discuss the steps necessary for placing the application in condition for allowance.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-0638. Should such

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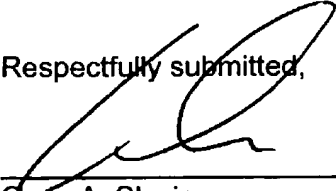
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fees be associated with an extension of time, applicant respectfully requests that this paper be considered a petition therefor.

3/21/06  
Date

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Respectfully submitted,

  
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